

REMARKS

After entry of the amendments, claims 1-11 and 13-20 are pending in this application. Claims 1, 11 and 13 have been amended. Claim 12 has been cancelled as being redundant in view of amended claim 11. Claim 15 has been amended to correct typographical errors. No new matter is believed to have been introduced by the amendments. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any subject matter of the claims as previously presented. Applicants expressly reserve the right to pursue any unclaimed subject matter in one or more continuation applications.

Attached hereto is a marked-up version of the changes made to the claims by the current amendments. The marked up version is captioned "Version with markings to show changes made".

Rejections Under 35 U.S.C. §102

Claims 1, 6, 7, 8, 10-12, 16-17 and 20 are rejected under 35 U.S.C. §102(a) and 102(e) as being anticipated by Biedermann et al. (U.S. Patent No. 6,150,403). Applicants submit that the claims as amended are not anticipated by Biedermann *et al.*

Biedermann *et al.* does not specifically disclose a fine mist *pump* spray for treating acne or acneform conditions comprising a salicylic acid solution, nor does Biedermann *et al.* disclose an article of manufacture comprising a salicylic acid solution contained within a fine mist *pump* spray dispenser, as claimed.

Biedermann et al. discloses that it's compositions may be in the form of "sprays" (col 12, line 52) and that such form "may comprise several types of carriers including...aerosols..." (col 12, lines 56-59). With respect to aerosols Biedermann et al. states at col. 13, lines 12-15 that their aerosols are formed "by adding a propellant to the solution" (col. 13, lines 12-13).

Biedermann et al. do not suggest aerosols that do not contain a propellant. In this regard as

X

stated in the last paragraph of page 3 of the applicant's specification "A pump spray is a formulation that does not contain a propellant..."

Accordingly, Biedermann et al. does not disclose a "fine mist pump spray" which is expressly part of claims 1-10 and 20 or a "fine mist pump spray dispenser" which is expressly part of claims 11-19. This reference, therefore, does not anticipate the claims as amended.

Claims 1, 7-12, 16-18 and 20 are rejected under 35 U.S.C. § 102 (a) and (e) as anticipated by O'Halloran et al. (U.S. Pat. No. 6,168,798 B1).

The claims as amended are not anticipated by O'Halloran et al. for essentially the same reasons as given above with respect to Biedermann et al. While O'Halloran et al. discloses a laundry list of forms their compositions may take that includes "aerosols sprays" (col. 6, line 8), there is no teaching of fine mist pump sprays or of fine mist pump spray dispensers. As shown by Biedermann et al., aerosol sprays typically contain a propellant. Further, with respect to applicants claim that specify the pH of the composition, it is clear that O'Halloran et al. does not teach or suggest that spray forms of their compositions should advantageously have a pH greater than 4.5. In this regard the reference teaches that its compositions generically (without respect to form) have a pH of "about 2.5 to about 5.5, preferably about 2.5 to about 4.5, more preferably about 3.3 to about 4.0. (col. 4 lines 25-27). As taught in applicant's specification, it is highly advantageous to use pH above 4.5 in salicylic acid fine mist sprays to lessen the likelihood of nasal/throat irritation and coughing.

Rejections Under 35 U.S.C. §103

Claims 3-5 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biedermann et al. (U.S. Patent No. 6,150,403) in view of Guang Lin et al. (U.S. Patent No. 5,612,321).

As stated above, Biedermann et al. fails to disclose fine mist pump sprays of salicylic acid, Guang Lin et al. says nothing about sprays or fine mist pump sprays. In this regard applicant disagrees with the Examiner's contention that col. 8, lines 29-58 of Guang Lin et al. describes sprays. Instead this citation appears to describe liquid "dab-on" applicators. Accordingly, this combination of references cannot possibly render the rejected claims obvious under 35 USC § 103.

Claims 2 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Biedermann et al. in view of Sciarra.

As indicated above, Biedermann et al. expressly teach that their aerosols contain propellant. The presently claimed sprays do not contain a propellant. It is noted in this regard that the portions of Sciarra cited in the Office Action are directed to propellant-containing aerosols. Furthermore, even if the secondary reference discusses fine mist pump sprays, there would be no motivation to combine such discussion with Biedermann et al. in view of the latter's specific teaching that aerosols contain propellant. Accordingly, the claims are not obvious over this combination of references.

Claim 13 is rejected under 35 U.S. §103(a) as being unpatentable over Biedermann et al. in view of Rhea (U.S. Pat. No. 5,195,664).

The secondary reference, Rhea, simply describes a spray pump dispenser. It says nothing about spraying cosmetic solutions let alone salicylic acid-containing anti-acne solutions. There would be no motivation to combine this secondary reference with Biedermann et al. because the latter says aerosols contain propellant. The Rhea dispensers do not involve a propellant. Accordingly, this combination of references fails to render the subject matter of claim 13 obvious.

For the reasons stated above, applicant believes the rejections are improper with respect to the claims as amended. Applicant accordingly, request the rejections be withdrawn and the amended claims allowed.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 425802000200. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: November 20 2001

By: Thomas E. Ciotti
Thomas E. Ciotti
Registration No. 21.013

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5702
Facsimile: (650) 494-0792

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

1. (Amended) A fine mist pump spray for treating acne or acneform conditions comprising a salicylic acid solution wherein the salicylic acid constitutes from about 0.01% to about 20% by weight of the solution.
2. The spray of claim 1 wherein the spray comprises liquid particles of a size of from about 10 to about 150 micrometers.
3. The spray of claim 1 wherein the pH of the solution is above about 4.5.
4. The spray of claim 3 wherein the pH is from about 5 to about 7.5.
5. The spray of claim 3 wherein the pH is from about 6.9 to about 7.2.
6. The spray of claim 1 wherein the solution contains one or more additional anti-acne agents.
7. The spray of claim 1 wherein the solution comprises a solvent system comprising water and a volatile solvent.
8. The spray of claim 7 wherein the volatile solvent is an alcohol.
9. The spray of claim 8 wherein the alcohol is denatured ethyl alcohol.
10. The spray of claim 1 wherein the salicylic acid constitutes about 0.5% to 2% by weight of the solution.

11. (Amended) An article of manufacture comprising a salicylic acid solution wherein the salicylic acid constitutes about 0.01% to 20% by weight of the solution contained within a fine mist pump spray dispenser.
12. (Cancelled)
13. (Amended) The article of claim 11 wherein the fine mist pump spray pump dispenser is a 360 degree fine mist pump spray pump dispenser.
14. The article of claim 11 wherein the pH of the solution is above about 4.5.
15. (Amended) The article of claim 14 wherein the pH is in the range of about 5 [and] to about 7.2.
16. The article of claim 11 wherein the solution comprises a solvent system comprising water and a volatile solvent.
17. The article of claim 16 wherein the solvent is an alcohol.
18. The article of claim 17 wherein the alcohol is denatured ethyl alcohol.
19. The article of claim 11 wherein the dispenser dispenses about 50 to 500 microliters of the solution per actuation.
20. A method for treating acne or acneform conditions in a human comprising administering an effective amount of the spray of claim 1 to the afflicted skin of said human.